

The Reply Brief of 05/18/2009 has been acknowledged and entered.

In Reply Brief Applicant argues that: "In the Examiner's Answer dated March 17, 2009, the Examiner set forth new arguments not previously on record. The Examiner asserts that independent claims 1 and 24 are not directed to patent eligible subject matter under 35 U.S.C. § 101 because claims 1 and 24 do not "require a machine for performing claimed method steps.""

In response to this argument the examiner points out that claims 1 and 24 were rejected under 35 U.S.C. § 101 in all Office actions during the history of prosecution, including Final Rejection of 08/25/2008. As follows, the examiner maintains his position that claims 1 and 24 fail the machine-or-transformation test, and, therefore, are non-statutory under § 101.

Claims 1 and 24 recite:

1. A beauty diagnostic method, comprising:
storing personal questions on at least one topic including characteristics of at least one external body condition, the personal questions being stored on a computer-readable storage medium;
selecting a set of personal questions from the personal questions stored on the computer-readable storage medium;
asking a subject the set of personal questions;
receiving answers to the set of personal questions;
based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject; and
informing the subject about the at least one customized set of testing material.

24. A beauty diagnostic method, comprising:

- storing personal questions on at least one topic including characteristics of at least one external body condition, the personal questions being stored on a computer-readable storage medium;
- selecting a set of personal questions from the personal questions stored on the computer-readable storage medium;
- asking a subject the set of personal questions;
- receiving answers to the set of personal questions;
- based on the received answers, selecting from a plurality of testing materials, at least one customized set of testing material for determining quantitative information that would aid in recommending at least one beauty product to the subject;
- providing the subject with the customized set of testing material;
- ascertaining the desired quantitative information by collecting data derived from use of the testing material on the subject; and
- based on the received answers and the ascertained quantitative information, recommending at least one beauty product to the subject.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

A claimed process is eligible for patent protection under 35 U.S.C. § 101 if:

"(1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing. See Benson, 409 U.S. at 70 ('Transformation and reduction of an article 'to a different state or thing' is the clue to the patentability of a process claim that does not include particular machines.');" Diehr, 450 U.S. at 192 (holding that use of mathematical formula in process 'transforming or reducing an article to a different state or thing' constitutes patent-eligible subject matter); see also Flook,

437 U.S. at 589 n.9 ('An argument can be made [that the Supreme] Court has only recognized a process as within the statutory definition when it either was tied to a particular apparatus or operated to change materials to a 'different state or thing' '); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is...an act, or a series of acts, performed upon the subject-matter to be transformed and reduced to a different state or thing.').⁷ A claimed process involving a fundamental principle that uses a particular machine or apparatus would not pre-empt uses of the principle that do not also use the specified machine or apparatus in the manner claimed. And a claimed process that transforms a particular article to a specified different state or thing by applying a fundamental principle would not pre-empt the use of the principle to transform any other article, to transform the same article but in a manner not covered by the claim, or to do anything other than transform the specified article." (*In re Bilski*, 88 USPQ2d 1385, 1391 (Fed. Cir. 2008))

Also noted in *Bilski* is the statement, "Process claim that recites fundamental principle, and that otherwise fails 'machine-or-transformation' test for whether such claim is drawn to patentable subject matter under 35 U.S.C. §101, is not rendered patent eligible by mere field-of-use limitations; another corollary to machine-or-transformation test is that recitation of specific machine or particular transformation of specific article does not transform unpatentable principle into patentable process if recited machine or transformation constitutes mere 'insignificant post-solution activity.'" (*In re Bilski*, 88 USPQ2d 1385, 1385 (Fed. Cir. 2008)). Examples of insignificant post-solution activity include data gathering and outputting. Furthermore, the machine or transformation must impose meaningful limits on the scope of the method claims in order to pass the machine-or-transformation test. Please refer to the USPTO's "Guidance for Examining Process Claims in view of *In re Bilski*" memorandum dated January 7, 2009, http://www.uspto.gov/web/offices/pac/dapp/opla/documents/bilski_guidance_memo.pdf.

It is also noted that the mere recitation of a machine in the preamble in a manner such that the machine fails to patentably limit the scope of the claim does not make the claim statutory under 35 U.S.C. § 101, as seen in the Board of Patent Appeals

Informative Opinion *Ex parte Langemyr et al.* (Appeal 2008-1495),
<http://www.uspto.gov/web/offices/dcom/bpai/its/fd081495.pdf> .

In claim 1, the steps of: "selecting", "asking", "receiving", "selecting" and "informing" do not require any machine or transformation. Furthermore, the fact that said personal questions being stored on a computer-readable storage medium does not require a machine or transformation for conducting said process. The remaining method steps would be performed even if said personal questions are stored as a printed brochure. The fact that said personal questions being stored on a computer-readable storage medium at most suggests that said questions are presented for the viewer on a display without any transformation of data or implementing any functionality by the computer after displaying, which (displaying) would constitute a trivial use of technology.

In fact, the claimed step of "storing" does not involve transformation, but rather only the tracking of information which remains and must remain unaltered because it has to be observed and a decision by a human must be made upon observing said information (questions). Same rationale applied to claim 24.

Accordingly, Claims 1 and 24 are not tied to a particular machine or apparatus nor do they transform a particular article into a different state or thing, thereby failing the machine-or-transformation test. As such, claims 1 and 24 are non-statutory under § 101.

The remaining Applicant arguments regarding Claim Rejections under 35 U.S.C. § 103 (a) have been fully addressed in the Examiner's Answer to Appeal Brief of 03/17/2009.

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